



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,226	02/13/2002	Naoya Yamato	219107US0	4816

22850 7590 08/25/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

KIM, VICKIE Y

ART UNIT PAPER NUMBER

1614

DATE MAILED: 08/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/073,226

Applicant(s)

YAMATO ET AL.

Examiner

Vickie Kim

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 5-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4&5. 6) ☐ Other:

DETAILED ACTION***Election acknowledged***

Applicants affirmation on the election with traverse of Group I, claims 1-4 is acknowledged. Applicants partially traverse the restriction requirement on the grounds where each invention is considered to be patentably distinct but related to each other and thus there would be no burden in searching the entire application. This argument is not persuasive. Even if each invention is related because of the same compound used in the invention, the argument is not persuasive, as not all groups encompassed by the application would be classified together(see previous office action, paper no.6) and the search required for each invention would be burdensome because each invention is found to be patentably distinct subject matter proven in numerous patent literatures.

Regarding "unrelatedness", the examiner intended to differentiate material differences between the patentable subjects (i.e. compound, gelling agent, cosmetic composition). If the expression is considered to be confusing, the examiner would like to withdraw the term(i.e."unrelated") used in the previous office action for the clarification purpose. The examiner's allegation is clearly reasoned in the previous office action where the invention is unrelated(now different or distinct to each other) if it can be shown that they have different effect or functions and they are not disclosed as capable of use together. Since the compound is used to make materially different compositions and thus, the compound is patentably distinct subject matter from the composition although it uses the very same compound. For instance, JP57202360 teaches a acylamino acid derivatives including N-lauroyl-glutamic acid dibutylamide used as a

Art Unit: 1614

stabilizer for making inks(product). JP04372671 uses N-lauroyl-glutamic acid dibutylamide as an antiglogger or used for prevent the smudge. Thus, the restriction requirment deems proper due to the reasons mentioned above and thus maintained as it is.

Furthermore, even if there were unity of classification, the search of the entire application in patent and non-patent literature (a significant part of the thorough examination) would be burdensome due to the reasons mentioned in previous office action(e.g. patentably distinct subject matter proven in numerous patent literature). Therefore the restriction requirement is maintained and made FINAL.

Status of Application

Acknowledgement is made of election filed May 19, 2003. The claims 1-11 are pending, and elected claims 1-4 are presented for the examination. The non-elected claims 5-11 are withdrawn from the consideration.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 1614

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hofrichter et al(US5591424).

Claims are directed to a compound having the general formula I as claimed.

Claims 3-4 specifically require several species (i.e. N-2-ethylhexanoyl-L-glutamic acid dibutylamide, N-decanoyl-L-glutamic acid dibutylamide or N-decanoyl-L-glutamic acid dibutylamide).

US'424 teaches the compounds encompassed by the general formula I required by the instant claims, see compounds belong to formula of second gellant, column 4, lines 35-45, especially when the R2 or R3 = independently amides and R1 = alkyl or aryl having from about 1 to about 26 carbon atoms, preferably 6-22 carbon atoms. US'424 contemplates N-acyl amino acid derivatives such as N-lauroyl-glutamic acid dibutylamide(having (CH2)10CH2 substitution on R1 position and butylamide substitutions on R2 or R3 positions) as the preferred species in his patent, see column 4, line 54. All the claimed compounds are encompassed by the generic formula taught in the cited reference.

Although applicant's claims require narrower scope than what US' 424 suggests in his generic formula(column 4, lines 35-43) and US'424 fails to specifically mention the same species required by the instant claims 3-4, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to substitute an amide for R2 and R3 and alkyl(straight or branched) having 7-10 carbon atoms among the possible substitution suggested in the patented disclosure at column 4, lines 43-50

Art Unit: 1614

because the formulating new compounds(i.e. N-ethylhexanoyl, N-decanoyl or N-octanoyl) using the same synthetic process(e.g. alkyl elongation) under the guidance are commonly practice in the art and well considered to be within the skilled level of the ordinary artisan, and thus, it would have been obvious absent evidence to the contrary.

One would have been motivated to do so because it is always desired to extend selection option of the end product to enhance the quality of utility where users could be benefited by increased selection option for the products. The satisfaction and compliance of user would be increased due to that individual selection based on the need and preference. Ultimately, increased the number of product allows cost-effective manufacture due to easy accessibility and the competition.

All the critical elements required by the instant claims are taught by the cited reference

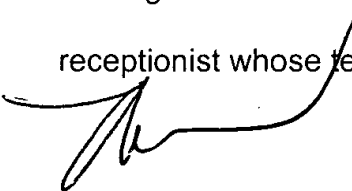
For the reasons above, all the claimed subject matter is not patentably distinguished over the prior art of the record and all the claims are properly included in this rejection.

Conclusion

1. No claims is allowed.
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickie Kim whose telephone number is 703-305-1675. The examiner can normally be reached on Tuesday-Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on 703-308-4725. The fax phone numbers for the organization where

Art Unit: 1614

this application or proceeding is assigned are 703-746-3165 for regular communications and 703-746-3165 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Vickie Kim,
Patent examiner
August 22, 2003
Art unit 1614